

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Pia M. CHALLITA-EID et al.

Application No.: 10/087,190

Allowed: February 11, 2009

Filed: February 28, 2002

Art Unit: 1643

For: NUCLEIC ACID AND CORRESPONDING
PROTEIN ENTITLED 121P1F1 USEFUL IN
TREATMENT AND DETECTION OF
CANCER

Examiner: D. Blanchard

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705

MS Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

On behalf of Applicants, the undersigned requests reconsideration of the patent term adjustment indicated in the Notice of Allowance. This application for patent term adjustment is being filed with payment of the issue fee and is, therefore, timely. The fee required under 37 CFR 1.705(b)(1) as set forth in 37 CFR 1.18(e) is enclosed with the present application.

Correct Patent Term Adjustment

Applicants respectfully request an additional credit of 44 days be added to the 114 days of adjustment as indicated on the Notice of Allowance. The additional credit, minus Applicants' delay, results in a revised total of 158 days of patent term adjustment.

Statement of Facts

According to the Office's Initial Determination of Term Adjustment received with the Notice of Allowance, mailed February 11, 2008, Applicants are entitled to 114 days adjustment of patent term. Applicants disagree with the Patent Term Adjustment of 114 days and reconsideration is respectfully requested.

The Office failed to mail a notification under 35 USC 132 or a notice of allowance under 35 USC 151 within 14 months of the filing date of the present application. The Office correctly credits Applicants with 427 days of adjustment in accordance with 35 USC 154(b)(1)(A)(i) and 37 CFR 1.702(a)(1), 1.703(a)(1).

Applicants filed a response on March 19, 2003, to a Notice to File Missing Parts of Nonprovisional Application, mailed October 28, 2002. The Office correctly calculates 50 days of Applicants' delay in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

Applicants filed a supplemental response on September 23, 2004, to an Election-of-Species Restriction, mailed June 28, 2004. The Office correctly calculates 31 days of Applicants' delay in accordance with 37 CFR 1.704(c)(8).

Applicants filed a response on February 22, 2005, to a non-final office action, mailed November 15, 2004. The Office correctly calculates 7 days of Applicants' delay in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

Applicants filed a response on December 1, 2005, to a non-final office action, mailed August 3, 2005. The Office correctly calculates 28 days of Applicants' delay in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

Applicants filed a request for continued examination on June 21, 2006, in response to a final rejection, mailed February 17, 2006. The Office correctly calculates 35 days of Applicants' delay in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

Applicants filed a response on April 4, 2007, to a non-final office action, mailed December 28, 2006. The Office correctly calculates 7 days of Applicants' delay in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

Applicants filed an Information Disclosure Statement on June 28, 2007, after the initial reply to a non-final office action was mailed April 4, 2007. The Office failed to calculate 85 days of Applicants' delay in accordance with 37 CFR 1.704(c)(8).

Applicants filed a request for continued examination on October 30, 2007, in response to a final rejection, mailed July 20, 2007. The Office correctly calculates 10 days of Applicants' delay in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

Applicants filed a Supplemental Information Disclosure Statement on December 21, 2007. The Office correctly calculates 52 days of Applicants' delay in accordance with 37 CFR 1.704(c)(8).

Applicants filed a response on July 14, 2008, to a non-final office action, mailed January 14, 2008. The Office correctly calculates 91 days of Applicants' delay in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

Applicants timely filed an amendment after final on December 23, 2008, in response to a final rejection, mailed October 24, 2008. Due to a misunderstanding, the Examiner issued an Advisory Action on January 16, 2009, to which the undersigned responded telephonically. As expressly requested by the Examiner during the telephone interview, Applicants submitted a supplemental response to the final rejection on January 26, 2009. These events are reflected in that response. The Office incorrectly calculates 2 days of Applicants' delay in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b). Based on the express request for the submission of a supplemental response by the Examiner, Applicants are entitled to an additional credit of 2 days in accordance with 37CFR 1.704(c)(8)

Based on a projected issue date of August 25, 2009, the Office will fail to issue a patent within 3 years after the date on which the present application was filed (December 28, 2002). Based on this projected issue date, Applicants are entitled to an additional credit of 127 days in accordance with 35 USC 154(b)(1)(B) and 37 CFR 1.702(b), 1.703(b).

Under the USPTO Exclusion Interpretation of 35 USC 154(b)(2)(A) and application of 37 CFR 1.703(f) Actual Delay Limitation, the Office would conclude that the 127 days of adjustment for failure to issue a patent within 3 years constitute “overlap” with the 427 days of adjustment for failure to issue an action within 14 months and thus, would not include the 127 days in the total calculation of term adjustment.

In light of Wyeth et al. v. Dudas, No. 07-1492 (D.D.C. September 30, 2008), Applicants assert that the Actual Delay Limitation under 37 CFR 1.703(f) is no longer applicable and thus, the 127 days of delay under the 3-Year PTO Issue of Patent rule should be added to the 427 days of delay under the 14-Month PTO First Action rule.

Applicants calculate a total PTO delay of 554 days and Applicants’ delay of 396 days, for a revised total of 158 days of additional patent term. Based on the foregoing information, Applicants respectfully request reconsideration of the patent term adjustment.

Conclusion

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing Docket No. 511582003420.

Dated: May 6, 2009

Respectfully submitted,

By: /Amy A. Mills/
Amy A. Mills

Registration No.: 58,906
MORRISON & FOERSTER LLP
12531 High Bluff Drive, Suite 100
San Diego, California 92130-2040
(858) 314-5461